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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,733	08/31/2001	Genichi Matsuda	122.1469	8403

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EXAMINER	
LAO, LUN YI	

ART UNIT	PAPER NUMBER
2673	9

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/942,733	MATSUDA ET AL.	
	Examiner	Art Unit	
	Lao Y Lun	2673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) *8,11-13 and 17-19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7, 9, 10, 14-16 and 20-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Rejections - 35 USC § 102/103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 20-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hashimoto et al(5,955,198).

Hashimoto et al teach a touch panel having a pair of panels(1, 2) with conductive films(3, 4), each of the panels(1,2) being spaced apart and coupled by a double-faced tape(6) comprising a shielding unit(5) provide adjacent of the double-faced tape(6) to prevent damage to one of the conductive films(4) of the pair of panels(1,2)(see figure 1; column 2, lines 29-43 and column 3, lines 14-56).

If applicants disagree that the adhesive layer(6) is not a double-faced tape, it would have been obvious to have the adhesive layer as a double-faced tape since it sticks two panels(1, 2) together(see figure 1; column 1, lines 33-36 and column 3, lines 23-25).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda et al(6,356,259) in view of Nakaishi et al(5,844,175).

As to claims 14-15, Maeda et al teach a touch panel having a pair of panels(2,3) each having a transparent conductive film(4,5) adhered on a transparent board which are arranged via electrically insulating spacers(6) and the pair of panels(2,3) are joined at perimeters via the adhesive tape(10)(see figures 1-2; column 6, lines 13-38 and column 7, lines 26-40). Maeda et al teach a conductive film damage preventing element(reactive adhesive) made of elastic material to prevent damage by the edge of the adhesive tape(double-faced tape 10)(see figures 1-2, 5; column 3, lines 54-68; column 4, lines 1-8 and column 7, lines 1-53).

Maeda et al fail to disclose the conductive film divided into a plurality of regions of desired forms by channels.

Nakaishi et al teach the conductive film(1) being divided into a plurality of regions of desired forms by channels(see figures 1A and 6) and a double-side adhesive

layer(10)(see figures 1-4C; column 5, lines 1-3 and column 6, lines 2-19). It would have been obvious to have modified Maeda et al with the teaching of Nakaishi et al, so drive control circuits for a touch panel could be integrated in the touch panel.

6. Claims 1-4, 9-10 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakaishi et al(5,844,175) in view of Aroyan et al(6,163,313) and Katsumura(JP 04-143823)..

As to claims 1-4, 9-10 and 14-16, Nakaishi et al teach a touch panel having a pair of panels(1, 2) each having a transparent conductive film(3a, 3b) adhered on a transparent board which are arranged via electrically insulating spacers(9)(see figure 1B; column 3, lines 47-68 and column 4, lines 1-21). Nakaishi et al teach the conductive film(1) being divided into a plurality of regions of desired forms by channels(see figures 1A and 6).

Nakaishi et al fail to disclose the channel is formed by laser etching and a conductive film damage preventing element.

Aroyan et al teach the conductive film(220, 205) being divided into a plurality of regions of desired forms by channels(305a or 305b) formed by laser etching(see figure 6B, 6C; column 14, lines 53-68; column 15, lines 1-3; and column 20, lines 10-18). It would have been obvious to have modified Nakaishi et al with the teaching of Arovan et al, because laser etching is accurate, speeding and controlling.

Katsumura teaches a conductive film damage preventing element(4) made of elastic material(rubber)(see figure 1; abstract and constitution). It would have been obvious to have modified Nakaishi as modified with the teaching of Aroyan et al, so as

to recover the conductive film being in dent and prevent detection errors due to discrepancies in the position being pressed and that which is actually sensed.

As to claims 2-4, Nakanishi et al teach a plurality of electrode circuits connected to different external conductive wires are provided on the conductive film(3b) which is divided into the same number of regions as the electrode circuits, and boundary lines are formed with narrow channels so that said plurality of electrode circuits are not short-circuited(see figures 1A and 6).

As to claims 9-10 and 14-16, Nakaishi et al teach a double-faced tape(10)(see figures 1A, 1B, 4F, 7; column 1, lines 55-52; column 5, lines 1-3 and column 6, lines 17-19).

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakaishi et al(5,844,175) in view of Aroyan et al(6,163,313), Katsumura and Hino et al(6,168,910).

Nakaishi et al as modified fail to point out the diameter of laser spot is 0.1mm to 2mm,

Hino et al teach the diameter of a laser spot for etching is about 0.1mm(see column 1, lines 26-36). It would have been obvious to have modified Nakaishi et al as modified with the teaching of Hino et al, since one ordinary skill in the art would find the best size(around 0.1 mm diameter) of a laser spot for achieving the best result of laser etching.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakaishi et al(5,844,175) in view of Aroyan et al(6,163,313) , Katsumura and Sukenori et al(5,943,106).

Nakaishi et al as modified fail to point out wavelength of the laser light is 900nm or more.

Sukenori teaches the wavelength of a laser light for etching is more than 900nm (see figure 1 and column 6, lines 18-25). It would have been obvious to have modified Nakaishi et al as modified with the teaching of Sukenori since one ordinary skill in the art would find the suitable wavelengh(e.g. around 900nm) of the laser light for achieving the best result of laser etching.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakaishi et al(5,844,175) in view of Aroyan et al(6,163,313) , Katsumura and Yamagishi et al(5,349,155).

Nakaishi et al as modified fail to point out pulse width of the laser light is 1ns.

Yamagishi et al teach the pulse width of a laser light for etching is 1ns(see figure 1 and column 3, lines 27-39). It would have been obvious to have modified Nakaishi et al as modified with the teaching of Yamagishi et al since one would select the best pulse width(about 1ns) to perform a laser etching function according to his/her experience to achieve the best result of laser etching and the pulse width of laser would be changed via the frequency of laser.

Response to Arguments

10. Applicant's arguments filed on May 3, 2004 have been fully considered but they are not persuasive.

Applicants argues that Maeda et al's reactive adhesive can not both correspond to the double-faced tape and also prevent damage by an edge thereof on page 7. However, the reactive adhesive corresponds to the conductive film damage preventing element and the adhesive tape(10) corresponds to the double-side tape(see figures 1, 4-5; column 7, lines 13-53 and paragraph #2 above).

Applicants argue that Maeda et al's adhesive layer 10 is not a double-faced tape on page 7. The examiner disagrees with that since the adhesive layer(10) located between the upper transparent plate(2) and the lower transparent plate(3) and the adhesive layer sticks two plates(2, 3) together(see figure 2 and column 7, lines 26-36).

Applicants argue that Nakanishi et al do not teach a conductive film damage preventing element on page 7. The examiner is in agreement. However, Nakanishi et al is not cited for teaching such feature, but Maeda et al do it.

Applicants argue that Aroyan et al and Hino et al do not teach a conductive film damage preventing element on pages 8 and 9. The examiner is in agreement. However, Nakanishi et al is not cited for teaching such feature, but Katsumura does it.

Applicants argue that Katsumura's conductive film damage preventing element is not for preventing damage from a double-faced tape on page 9. The examiner disagrees with that since Katsumura teaches the damage from the gap holding

material(see page 4, lines 13-17 of Katsumura's translation) and a double-faced tape(10) is a gap holding member for holding two planes together(see figure 1 and column 5, lines 1-3). 5,844,175

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lun-yi, Lao whose telephone number is (703) 305-4873.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala, can be reached at (703) 305-4938.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

June 12, 2004

Lun-yi Lao
Primary Examiner